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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/523,029
Filing Date: September 07, 2005
Appellant(s): STENZEL ET AL.

Harris A. Pitlick
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/29/2009 appealing from the Office action mailed 03/10/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

However, an appeal in US 10/522,672 may have a bearing on the Board's decision in this appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: the rejection Ground (A) in view of US 6,180,076 B1 (Urhlandt et al.) is maintained. Examiner would like to clarify that the patent number is 6,180,076 B1, not 6,180,876 B1.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejections Ground (B) in view of US 5,705,137 (Goerl et al.) and Ground (C) in view of US 2003/0003040 (Lindner et al.) have been withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,180,076 B1 Uhrlandt et al. 1-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Election/Restrictions

i. Applicant's election with traverse of Group I, claims 1-4, in the reply filed on 01/31/2008 is acknowledged. The traversal is on the ground(s) that "no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctiveness between the identified groups" and that "it has not been shown that a burden exists in searching the claims of the two groups" (see Remarks filed 01/31/2008). This is not found persuasive because the application's special technical feature, a precipitated silica with a BET surface area of 178-302 m²/g, a CTAB surface area of \geq 170 m²/g, a DBP number of 200-300 g/(100g), and a Sears number V₂ of 10-35 ml/ (5g), is not novel over the prior art (see written restriction requirement issued in the Office Action dated 12/31/2007) (Goerl et al., U.S. Patent No. 5,705,137).

The requirement is still deemed proper and is therefore made FINAL.

ii. Claims 5-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 01/31/2008.

Nonstatutory Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

i. Claims 1-4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 13 of U.S. Patent No. 6,180,076 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the precipitated silica of U.S. Patent No. 6,180,076 B1 has physical and chemical properties that fall within the ranges of those of the precipitated silica of the instant invention.

Properties	Instant Invention	6,180,076 B1
BET surface area (m ² /g)	190-302 (claim 1)	120-300 (claim 1)
CTAB surface area (m ² /g)	≥170, ≤300 (claims 1 and 2)	100-300 (claim 1)
DBP number (g/(100g))	200-300 (claim 1)	150-300 (claim 1)
Sear number V2 (ml/(5g))	10-20 (claim 1)	6-25 (claim 1)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

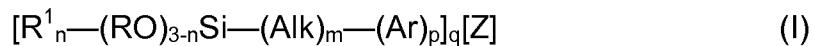
The person having ordinary skill in the art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The references of record in this application reasonably reflect this level of skill.

i. Claims 1-4 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uhrlandt et al (U.S. Patent No. 6,180,076 B1).

Uhrlandt et al. is drawn to a precipitated silica with the following physical and chemical properties (col. 1 lines 40-50, col. 2 lines 5-15 and lines 25-34, col. 3 lines 45-49, col. 6 lines 15-52, col. 9 Example 8 Product name KS ex. 5, *Applicants' claims 1-3 and 21-28*):

BET surface area	200-300 m ² /g
CTAB surface area	100-300 m ² /g
DBP number	150-300 g/(100g)
Sears number V ₂	6-25 ml (consumption of 0.1 N NaOH)
WK coefficient	<3.4, preferably <2.5
Degraded particle size	<1.0 μm
Non-degraded particle size	1.0-100 μm.

The precipitated silica is modified with organosilanes of the formulae I to III (col. 3-4, *Applicants' claim 4*):





wherein:

Z: -SCN, -SH, -Cl, -NH₂ (if q=1), or -Sx--(if q=2),

R and R¹: an alkyl group having 1 to 4 carbon atoms, the phenyl radical, wherein all the radicals R and R¹ can each have the same or a different meaning,

R: a C₁-C₄ -alkyl, C₁-C₄ -alkoxy group,

n: 0, 1, or 2,

Alk: a divalent straight-chain or branched hydrocarbon radical having 1 to 6 carbon atoms,

m: 0 or 1,

Ar: an arylene radical having 6 to 12 C atoms, preferably 6 C atoms,

p: 0 or 1, with the proviso that p and n do not simultaneously denote 0,

x: a number from 2 to 8,

alkyl: a monovalent straight-chain or branched unsaturated hydrocarbon radical having 1 to 20 carbon atoms, preferably 2 to 8 carbon atoms,

alkenyl: a monovalent straight-chain or branched unsaturated hydrocarbon radical having 2 to 20 carbon atoms, preferably 2 to 8 carbon atoms.

Urhlandt et al. differs from the instant application in that the ranges of the BET surface area, the CTAB surface area, the DBP number, and the Sears number overlap and/or lie in the ranges of those of the instant application.

It would have obvious to one of ordinary skill in the art at the time of the invention **to have modified** the silica of Urhlandt et al. *by adjusting the ranges of the BET surface area, the CTAB surface area, the DBP number, and the Sears number* (col. 1 lines 40-50, col. 2 lines 5-15 and lines 25-34, col. 6 lines 15-52, col. 9 Example 8 Product name KS ex. 5), as per Applicants' claims 1, 2 and 21-25, **because** in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Furthermore, "[A] prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a prima facie case of obviousness." *In re Peterson*, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003). See MPEP 2144.05 [R-5]. Furthermore, a patent's disclosure is not limited to its examples or preferred embodiments. "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems which with they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. See MPEP 2123 [R-5].

(10) Response to Argument

With regard to the appellants' Argument section on pages 3-7 and 10 of the Appeal Brief, the appellants' main argument is that the parameters of the silica of

Uhrlandt et al. are significantly broader and inclusive of and/or overlap with the corresponding parameters of the present claims. For example, all of the Examples of Uhrlandt et al. are outside the terms of the present claims. The present inventors have succeeded in finding and demarcating, from an unimaginable number of theoretically disclosed silicas in Uhrlandt et al. those which are suitable for incorporation in motor bikes, trucks and high-speed automobile tires.

In response to appellant's argument that the parameters of Uhrlandt et al. and the Examples are significantly broader and inclusive of and/or overlap with the corresponding parameters of the present claims (1st paragraph and 1st full paragraph of page 4), Examiner respectfully points out that a patent's disclosure is not limited to its examples. "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems which with they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. See MPEP 2123 [R-5]. The prior art of record discloses and/or suggests the ranges claimed by the Applicants. One skilled in the art could have reasonably selected and optimized the claimed properties from the prior art to make the instant invention.

In response to appellants' argument that the silicas for commercial-vehicle tires have a requirements profile that is clearly different from that of passenger-car tires (2nd

full paragraph of page 4), Examiner respectfully points out that the claims are drawn to a silica, not to tires. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The intended use of the precipitated silicas carries no patentable weight. There is no mention of tires in the claims (the claims that do present a tire have been withdrawn and the restriction requirement has been made final).

In response to appellants' argument that the claimed "combination of parameters," in effect, claims only a very small and narrow part of the disclosure of Uhrlandt et al., Examiner respectfully points out that the instantly claimed ranges are overlapping with and/or encompassed by Uhrlandt et al., which is a clear case of prima facie obviousness.

In response to appellants' argument that the parameters must be considered in combination in order to determine the optimal silica for commercial-vehicle tires and the Die C test according to ASTM D 624 shows that the instant example has a higher value than the examples of Uhrlandt et al., wherein the higher the value, the greater the high-temperature tear resistance (Wehmeier Declaration filed June 20, 2008) (2nd full paragraph of page 5 through 1st full paragraph of page 6), the examples of Uhrlandt et al. cannot be compared to the instant invention because none of the examples of Uhrlandt et al. have all the parameters within the instantly claimed ranges. A patent is not limited to its examples or preferred embodiments. Appellants' have not shown that

a silica of Uhrlandt et al. with parameters as per the instant invention would not have a similar value as determined by the Die C test.

In response to appellants' argument that the closest prior art to the presently claimed invention is Example 4 in Uhrlandt et al. and that it doesn't present a case of *prima facie* obviousness (Wehmeier Declaration filed January 15, 2009), the examples of Uhrlandt et al. cannot be compared to the instant invention in any way because none of the examples of Uhrlandt et al. have all the parameters within the instantly claimed ranges. A patent is not limited to its examples or preferred embodiments. Appellants' have not shown that a silica of Uhrlandt et al. with parameters as per the instant invention would not have a similar value as determined by the Die C test.

In response to appellants' argument that the property of superior high-temperature tear resistance that the presently claimed silica imparts to a tire has been shown to be an inherent property of the silica and therefore need not be recited in the claims (last full paragraph of page 6 through page 7), appellant has failed to show that the silica of Uhrlandt et al. does not posses said inherent property. The examples of Uhrlandt et al. cannot be compared to the instant invention in any way because none of the examples of Uhrlandt et al. have all the parameters within the instantly claimed ranges. A patent is not limited to its examples or preferred embodiments. Appellants' have not shown that a silica of Uhrlandt et al. with parameters as per the instant invention would not have a similar value as determined by the Die C test.

In response to appellants' argument that the obviousness-type double patenting rejection is untenable and should not be sustained (page 10), the claims and disclosure of Uhrlandt et al. present a clear case of *prima facie* obviousness.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Serena L. Hanor/

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